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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WAYNE M. BLACKWELL and MARK GRANDSTAFF

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Appeal 2008-1430  
Application 10/602,711  
Technology Center 3600

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Decided: September 26, 2008

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Before HUBERT C. LORIN, LINDA E. HORNER, and JOSEPH A.  
FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-26. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM IN PART.

### THE INVENTION

Appellants claim a loading assembly and method of use which is said to effectuate the positioning and loading of mail objects in variable sized containers. (Specification 1: 11-13.)

Claims 1, 17, 21, and 25, reproduced below, are representative of the subject matter on appeal.

1. An apparatus for loading mail objects, comprising:  
a bucket assembly which holds a container;  
an actuator system moving the bucket assembly between at least an upright position, an intermediate tilt position and a full tilt position;  
at least one sensor which detects whether the bucket assembly has reached a fill capacity at each of the upright position, the intermediate tilt position and the full tilt position; and  
a feedback control system which controls an indexing of the bucket assembly, via the actuator system, between the upright position, the intermediate tilt position and the full tilt position, wherein in the intermediate position, packages or other mail objects are permitted to settle within the bucket assembly such that additional packages or other mail objects can be introduced into the bucket assembly in the intermediate position.

17. A loading system, comprising:  
a transporting and sorting system, including:  
an induction mechanism that introduces

packages onto a transporting system which transports the packages from the induction mechanism to a plurality of drop off positions;  
a chute associated with each of the plurality of drop off positions; and  
a loading apparatus, comprising:  
a bucket assembly which holds a container;  
an actuator system moving the bucket assembly between at least an upright position, an intermediate tilt position and another tilt position;  
at least one sensor which detects whether the bucket assembly has reached a fill capacity at each of the upright position, the intermediate tilt position and the another tilt position; and  
a feedback control system which controls an indexing of the bucket assembly, via the actuator system, between the upright position, the intermediate tilt position and the another tilt position.

21. A method for loading packages, comprising the steps of:  
placing a container in a first tilt position;  
detecting when the container is full at the first tilt position;  
indexing the container to an intermediate tilt position to enable settling of contents within the container;  
detecting when the container is full at the intermediate tilt position; and  
indexing the container to an upright position.

25. A control system for loading packages, comprising:  
a module which detects when a container is full at a first tilt position, an intermediate tilt position and an upright position;  
a module which detects a position of the

container; and  
a module which controls a movement of  
the container based at least on a capacity of the  
container.

### THE REJECTIONS

The Examiner relies upon the following as evidence of  
unpatentability:

|        |              |               |
|--------|--------------|---------------|
| Wilde  | US 4,875,327 | Oct. 24, 1989 |
| Herrin | US 5,797,716 | Aug. 25, 1998 |

The following rejections are before us for review.<sup>1</sup>

1. Claims 1, 3-17, 19-22 and 24-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wilde.
2. Claims 2, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilde in view of Herrin.

### ISSUES

The anticipation issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 1, 3-17, 19-22, and 24-26 under 35 U.S.C. § 102(b) as anticipated by Wilde. This anticipation issue turns in part on whether Wilde expressly or inherently discloses at least one sensor which detects whether the container has reached a fill capacity at each of the upright position, the intermediate tilt position and the full tilt position.

The other issue before us is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 2, 18, and 23 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Wilde in

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<sup>1</sup> The Examiner's Answer on page 7 states that the 35 U.S.C. 112, second paragraph rejection is withdrawn.

view of Herrin. This issue turns in part on whether a person with ordinary skill in the art would have known to incorporate the position sensors in Herrin into the container support of Wilde.

### FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Wilde discloses a container filling apparatus 10 having an upright position defined by the fully lowered position of the container support (FF 6), and, as described below, having a full tilt position, and an intermediate position wherein

[a]t the start of the filling cycle container filling apparatus 10 raises container 22 and lowers conveyor discharge section 18 to reduce the drop from discharge section 18 into container 22 [(read as the full tilt position)]. During the filling cycle, as parts are deposited into container 22, container support 14 initially lowers container 22 through an initial filling phase. During this initial filling phase conveyor discharge section 18 is maintained in a lowered position. After the initial filling phase, container support 14 continues to lower container 22 in response to the accumulation of parts in container 22, while conveyor discharge section 18 is simultaneously raised [one of the continued lowered positions is read as an intermediate position)].

(Wilde, col. 3, ll. 7-19.)

2. Wilde discloses that desirably, the

[c]ontainer filling apparatus 10 therefore completely fills container 22 while throughout the fill cycle apparatus 10 maintains a preselected range of spacing between discharge section 18 and

the pile of accumulated parts within container 22. This reduces or minimizes the drop from discharge section 18 to the surface first struck by the dropped part, whether that surface is the inside of container 22 or the top of the pile of accumulated parts.

(Wilde, col. 3, ll. 19-27.)

3. Wilde discloses that

[a] parts back-up sensor 130 (FIG. 4) is located on discharge section 18 adjacent discharge end 75. Sensor 130 is mounted on a sensor bracket 132 projecting from conveyor sidewall 73. Sensor 130 most preferably is a photoelectric sensor positioned to detect the back-up of parts at discharge end 75. A deflector bracket 131 projects from each sidewall 73 upstream of sensor 130, which prevent parts from jamming sensor 130. Alternatively, sensor 130 may preferably be a mechanical switch that is thrown by the back-up of parts at discharge end 75, or other alternative sensors. Sensor 130 is connected to a conventional adjustable timer circuit that prevents sensor 130 from generating a signal until sensor 130 detects a parts back-up for a preselected time interval. Although this time interval is adjustable, the preferred time interval is five seconds.

(Wilde, col. 5, ll. 45-60.)

4. Wilde discloses that “[t]he raising of conveyor support 14 releases discharge section 18 to pivot downwardly due to gravitational forces. Discharge end 75 is most preferably spaced at most approximately six inches above the back wall of container 22 located below discharge end 75.”

(Wilde, col. 6, ll. 44-49.)

5. Wilde discloses that when the

[c]onveyor 16 is activated, causing parts to be conveyed onto discharge section 18 and then discharged into container 22. Preferably, the greatest drop from discharge end 75 is that which occurs at the start of the fill cycle, which is at most about six inches down to the contact surface of the container. The parts drop into container 22 and commence piling up until sensor 130 determines a parts back-up at discharge end 75 that is sustained for the preselected time interval. In response to sensor 130, cylinder 66 pivots container support 14 downwardly until sensor 130 is cleared. Parts continue to be conveyed to container 22, with the result that through the majority of the fill cycle parts are pushed off of discharge end 75 onto the accumulated pile with little or no drop from discharge end 75 onto the contact surface of the pile. Through an initial filling phase of the filling cycle, container support 14 pivots downwardly without change in elevation of conveyor discharge end 75. Parts accumulate within container 22 after little or no fall from discharge end, with the maximum fall preferably being approximately six inches from discharge end 75.

(Wilde, col. 6, ll. 50-68.)

6. Wilde discloses a limit switch wherein

[a]n adjustable limit switch 156 (FIG. 2) is mounted on one vertical leg 32. Adjustable limit switch 156 is mounted so as to be movable out into the path of container support 14 and contact one sidewall 54. Adjustable limit switch 156 is also adjustable forward and backward so as to selectably contact sidewall 54 at a range of locations through the lowering cycle of container support 14. Adjustable limit switch 156 is connected in the circuit with controls 154, so that when adjustable limit switch 156 is contacted



conveyor 16 is shut down and container support 14 is lowered to the fully lowered position (FIG. 3).

(Wilde col. 6, ll. 8-19.)

7. Wilde discloses a safety switch in the form of

...[a] fixed limit switch 158 is fixedly mounted on one vertical leg 32 beneath adjustable limit switch 156. Fixed limit switch 158 is positioned to be contacted by container support 14 when container support is lowered to a fully lowered position (FIG. 2). Fixed limit switch is connected in a circuit with controls 154, so that when fixed limit switch 158 is contacted cylinder 66 is shut off and the lowering of container support 14 stops. Alternatively fixed limit switch 158 may additionally light a signal light or sound an operator alarm.

(Wilde col. 6, ll. 22-32.)

8. The Examiner found that

Wilde discloses an actuator system 66 that moves a bucket assembly 10, 12, 14 between upright (FIG. 1), intermediate (C6/L58-62) and full tilt (FIG. 2) positions, at least one sensor 130, 156 which detects whether a bucket assembly has reached a fill capacity at each of the upright positions, intermediate positions and full tilt positions, a feedback control system which controls bucket assembly indexing (indicated generally as 200). And, where "to settle" is defined as "to put into order; arrange or fix definitely as desired" ([www.dictionary.com](http://www.dictionary.com)) Wilde discloses putting in order to prevent damage to packed parts. C1/L45-C2/L20. It is noted that one sensor only is required to sense a fill capacity at each of the three positions.

(Answer 3-4.)

9. Herrin discloses detecting whether a container is positioned in a container holder by using

[p]osition sensors, e.g., optical sensors or detectors 66, 67 ... positioned adjacent the respective upstream and downstream ends of the container holder 45 and be connected to the time and position controller 61 for sensing the entering and exiting of containers C therethrough.

(Herrin, col. 6, ll. 56-60.)

#### PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these

questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 1739. “In

*United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40. “*Sakraida and Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

*Id.* at 1740-41. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

### ANALYSIS

The rejections are reversed as to claims 8, 14, 15 and 18, and affirmed as to claims 1-7, 9-13, 16, 17, 19-26. Appellants do not provide a substantive argument as to the separate patentability of claims 3, 4, 6, 7, 9-13, 24, and 26 that depend from claims 1, 21, and 25, respectively, which are the sole independent claims among those claims. Therefore, regarding the claims whose rejection is affirmed, we address only claims 1, 2, 5, 16, 17, 19-23 and 25. Claims 3, 4, 6, 7, 9-13, 24, and 26 fall with claims 1, 21, and 25.

Appellants’ challenge to the rejection of independent claims 1, 17, 21, and 25 under 35 U.S.C. § 102(b) is based on perceived deficiencies of Wilde. Inasmuch as Appellants raise the same issues with respect to each of these claims, we discuss the rejection of these claims together, addressing each of Appellants’ arguments in turn.

Appellants argue

the so-called sensors 130 and 156 do not detect whether the bucket assembly has reached a fill capacity at each of the upright position, the intermediate tilt position and the full tilt position,

for example.

The Examiner is respectfully directed to col. 6, line 33 to col. 7, line 26 of WILDE which specifically explains that the initial movement of the container support 14 is controlled by an operator. Thereafter, the filling takes place under the influence of the back-up sensor which detects back-up of the parts on the discharge end 75 of a discharge section 18. Such language is hardly suggestive of detecting when a bucket assembly is full at each of a first tilt position, an intermediate tilt position and an upright position.

(Appeal Br. 8-9, 12-15.)

Conversely, the Examiner found that Wilde discloses "...at least one sensor 130, 156 which detects whether a bucket assembly has reached a fill capacity at each of the upright positions, intermediate positions and full tilt positions ..." (FF 8). We are not persuaded of error in the Examiner's findings here. First, Wilde discloses upright, intermediate and full tilt positions for the container support 14. (FF 1.) Wilde also discloses that parts drop into container 22 and commence piling up until sensor 130 determines a parts back-up at discharge end 75 that is sustained for the preselected time interval. (FF 8.) This occurs in order to "...completely fill[] container 22 ... throughout the fill cycle ...." (FF 2.) The sensor 130 in Wilde is mounted on the distal end of the conveyor discharge 18 such that during a fill cycle the distal end is located within the container 22 only six inches above the receiving surface on the container. (FF 4, 5.) Thus, when the sensor 130 is activated it signifies that the volume of the container has been filled to the point where there is no longer a space, i.e., six inches, between the end of the conveyor discharge 18 and the top surface of the pile.

Accordingly, we interpret the condition in Wilde where this gap is filled by parts and so detected by the sensor 130 to constitute the fill capacity for a given position of the container as required by the claims.

Appellants' arguments directed to the deficiency of the limit switches 156 and 158 to detect the fill status of the container is noted (Appeal Br. 10-11, 14, 16). However, as discussed *supra*, it is the sensor 130 and not the limit switches 156 and 158 in Wilde which we read as being responsible for sensing the fill capacity of the container 22 at each of the indexed positions.

We are further not persuaded by Appellants' arguments challenging the use of an operator in Wilde to direct the initial movement of the support 14. This is because according to Wilde once initial positioning of the support 14 by the operator is accomplished, the discharge conveyor section 18 is automatically released and the container support 14 is automatically indexed until it is lowered to its fully lowered position (FF 5, 6). Further, the argument simply "fail[s] from the outset because . . . [it is] not based on limitations appearing in the claims . . .," and is not commensurate with the broader scope of the independent claims which merely require that indexing occur between upright, intermediate and full tilt positions, and do not require automatic positioning to get to the full tilt position. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

*Claim 5 Rejection under 35 U.S.C. § 102(b)*

Claim 5 recites a safety sensor associated with the actuator assembly to ensure shut down of the actuator assembly based on a detected problem. Appellants separately challenge the rejection of claim 5 maintaining that:

The Examiner identifies limit switch 158 in

WILDE as the recited a safety sensor associated with the actuator assembly to ensure shut down of the actuator assembly based on a detected problem. However, the Examiner has failed to appreciate that WILDE describes the limit switch 158 as merely detecting "when container support is lowered to a fully lowered position" (see col. 6, lines 24-26). Thus, the Examiner is not correct that WILDE discloses a safety sensor associated with the actuator assembly to ensure shut down of the actuator assembly based on a detected problem.

(Appeal Br. 17.)

We are not persuaded by Appellants' argument of error here because as found *supra* (FF 7) the switch 158 does more than simply detect the lowermost position of the support 14. Rather, the switch 158 is connected in a circuit with controls 154, so that it causes the cylinder 66 to shut off and the lowering of container support 14 stops. Further adding to the safety characteristic of the switch 158 is the disclosure in Wilde that "...limit switch 158 may additionally light a signal light or sound an operator alarm." (FF 7.) Thus, the switch 158 acts as a safety switch to detect the problem of continued actuator movement of the support 14 when the support has bottomed out on the device thereby preventing actuator overload or burn out.

*Claim 8 Rejection under 35 U.S.C. § 102(b)*

Claim 8 recites a chute sensor which detects package or mail object backlog within the chute upstream from the bucket assembly. As discussed above, the sensor 130 which is located on a chute or conveyor, detects whether the bucket assembly has reached a fill capacity at each of the upright position, the intermediate tilt position and the full tilt position. Thus



we read sensor 130 as the fill capacity sensor and not the chute sensor required by claim 8. Having found no other sensor disclosed in Wilde on the conveyor or chute 18, we cannot sustain the rejection of claim 8 under 35 U.S.C. § 102(b).

*Claims 14 and 15 Rejection under 35 U.S.C. § 102(b)*

Claim 14 recites that the bucket assembly includes a floor assembly and a rear wall assembly for supporting any variable sized containers, the rear wall assembly including a substantially coplanar surface, where one surface of the coplanar surface is raised with respect to another surface of the coplanar surface.

We do not understand how one surface of a coplanar surface can be raised with respect to another surface of a coplanar surface because by definition a coplanar surface has all surfaces contained in a single plane.

We therefore, pursuant to our authority under 37 C.F.R. § 41.50(b), enter a new ground of rejection of claim 14, and claim 15 which depends therefrom, under 35 U.S.C. § 112, second paragraph as indefinite for the reasons set forth above.

In regard to the rejection of claims 14 and 15 under 35 U.S.C. § 102(b), our uncertainty as to what is meant by the claim language found in claim 14 provides us with no proper basis for making a comparison between that which is claimed and the prior art as we are obliged to do. Rejections under 35 U.S.C. § 102(b) should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." *In re Steele*, 305 F.2d 859, 862, (CCPA 1962). Accordingly, we are constrained to reverse, *pro forma*, the Examiner's

rejections of claims 14 and 15 under 35 U.S.C. § 102(b). We hasten to add that this is a procedural reversal rather than one based upon the merits of the section 102(b) rejection.

*Claims 16, 19, and 20 Rejection under 35 U.S.C. § 102(b)*

Claim 16 recites a feedback control system is a positional feedback system associated with the actuator assembly for controlling the movement of the bucket assembly, and claim 19 covers the positional feedback feature more broadly. We find that in Wilde cylinder 66 pivots container support 14 downwardly in response to the sensor 130 generating a signal indicating that the conveyor is backed up and does so until the sensor 130 is cleared. (FF 5.) As such, we consider the signal issued by the sensor 130 until the sensor is cleared to be a feedback signal because the actuator cylinder 66 continues to move the support 14 until the sensor is cleared.

Claim 20 recites position sensors providing feedback signals to a controller for indexing the bucket assembly. We do not find error in the Examiner's rejection of this claim because Wilde discloses position sensors or switches 156 and 158 connected in the circuit with controls 154, so that when the switches 156 and 158 are contacted by the container support 14, the container support is thus lowered and/or stopped based on the actual position fed back to the controls 154. (FF 6.)

*Claim 22 Rejection under 35 U.S.C. § 102(b)*

Claim 22 recites the steps of detecting when the container has reached full capacity in the upright position and removing the container. Appellants argue that Wilde "...does not disclose detecting when the container has

reached full capacity in the upright position and removing the container.”  
(Appeal Br. 23.) However we find that Wilde discloses completely filling container 22 with accumulated parts (FF 2) and which fill cycle includes full tilt, intermediate and upright positions (FF 1). As such, we do not find error in the Examiner’s rejection of claim 22.

*Rejection of claims 2, 18 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Wilde in view of Herrin*

Appellants argue the deficiency in the 35 U.S.C. § 103(a) rejection is that

sensors 66 and 67 of HERRIN merely sense "the entering and exiting of containers C" through "the container holder" (see col. 6, lines 56-60). This is not the same as sensing the proper positioning of a container. Instead, such sensors only detect a passing of a container at certain points.

(Appeal Br. 26.)

In light of the breadth of the claims, the Appellants’ argument is not persuasive as to error in the rejection. Claim 2 only requires a sensor determining whether any variable sized mail holding container is properly positioned within the bucket assembly, and claim 23 only requires detecting whether the container is properly positioned prior to loading the container with the content. Thus, all that is being claimed is detecting the presence of something at a given location. This is taught by Herrin because the sensors 66 and 67 in Herrin function to sense a container in the container holder 45 and thus detect its presence therein. In this sense, when the sensors 66 and 67 are incorporated into the support 14 in Wilde as proposed by the

Examiner (Final 4-5), they would sense if a container is or is not in place on the support 14. A person with ordinary skill in the art would know to position the sensors 66 and 67 of Herrin in such a way on the support 14 in Wilde so as to accommodate various sized containers and to insure correction if a container was not properly seated to receive the incoming parts.

Appellants' arguments to the deficiencies of Wilde on page 26 of the Appeal Brief are not persuasive for the reasons addressed above in the 35 U.S.C. § 102(b) rejection.

Claim 18 requires a chute sensor located proximate to the chute which detects package backlog on the chute. As discussed *supra* regarding claim 8, Wilde does not disclose a second chute sensor and Herrin fails to cure this deficiency in claim 18. Thus, we will also not sustain the rejection of claim 18.

### CONCLUSIONS OF LAW

1. We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1, 3-7, 9-13, 16, 17, 19-22, 24-26 under 35 U.S.C. § 102(b) as anticipated by Wilde and claims 2 and 23 under 35 U.S.C. § 103(a) as unpatentable over Wilde in view of Herrin.

2. We conclude the Appellants have shown that the Examiner erred in rejecting claim 8 under 35 U.S.C. § 102(b) as anticipated by Wilde and claim 18 under 35 U.S.C. § 103(a) as unpatentable over Wilde in view of Herrin.

3. We enter a new ground of rejection of claims 14 and 15 under 35 U.S.C. § 112, second paragraph as being indefinite and reverse *pro forma*

the Examiner's rejection of claim 14 and 15 under 35 U.S.C. § 102(b) as anticipated by Wilde.

### DECISION

The decision of the Examiner to reject claims 1-7, 9-13, 16, 17, and 19-26 is AFFIRMED.

The decision of the Examiner to reject claims 8, 14, 15 and 18 is REVERSED.

### FINALITY OF DECISION

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART; 37 CFR § 41.50(b)

hh

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